

REMARKS

Upon entry of this amendment, claims 1-3, 5-14, and 17-22 will be pending in the application. The Examiner has withdrawn claims 6-13, 17, and 18 from consideration as being drawn to a non-elected invention. By this amendment, claims 1, 5, and 14 are amended for the Examiner's consideration, and claims 4, 15, and 16 are canceled without prejudice or disclaimer. The above amendments do not add new matter to the application and are fully supported by the original disclosure. For example, support for the amendments is provided at lines 6-9 of page 4 of the specification. Applicants reserve the right to file the subject matter of one or more of the canceled claims in one or more continuing applications. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

Amendment is Proper for Entry

Applicants submit that the instant amendment is proper for entry because the amendment places the application in condition for allowance by incorporating the subject matter of indicated allowable claim 4 into independent claim 1. As the subject matter of claim 4 has already been previously considered by the Examiner, this amendment does not raise new issues that would require further search or consideration.

Alternatively, Applicants submit that the instant amendment places the application in better form for appeal by reducing the issues for appeal.

Allowed Claims

Applicants appreciate the indication that claims 4, 5, and 14-16 contain allowable subject matter. By this amendment, claims 4 is written in independent form by amending claim 1 to

incorporate the features of claim 4 and canceling claim 4. Therefore, claim 1 should be allowed, as should claims 2, 3, 5, 14, 19, and 20, which depend from claim 1. Moreover, Applicants submit that all of the pending claims are in condition for allowance for the following reasons.

Objection to Specification

The specification is objected to for failing to provide support for the recitation “at least one paper free layer...” in claim 21. This rejection is respectfully traversed.

Applicants note that claim 21 recites “at least one paper free layer of a transparent synthetic resin,” and submit that the specification provides support for this feature. Specifically, after describing the problems associated with using a printed paper layer that is attached to a support board, the specification discloses a support board having a decoration printed directly on the top side of the support board, wherein the decoration is covered by at least one layer of transparent synthetic resin. The specification explicitly states that “[b]y virtue of this configuration, the paper layer is eliminated” (page 3, lines 12-13) and “[t]he absence of paper layers prevents the resulting boards from warping” (page 4, lines 7-8). This description provides clear basis for the recitation “at least one paper free layer of a transparent synthetic resin” in claim 21.

The Examiner, in the Final Office Action dated September 19, 2007, contends that the recitation “at least one paper free layer of a transparent synthetic resin” means that other layers in the wood fiberboard can have paper. Applicants respectfully disagree, and submit that the recitation “at least one paper free layer of a transparent synthetic resin” does not positively recite, or even imply, that there are other layers of the wood fiberboard containing paper. Instead, the recitation merely refers to at least one layer of resin, wherein the resin is paper free, transparent,

and synthetic. That is to say, the modifiers “paper free,” “transparent,” and “synthetic” all modify the term resin, of which there is at least one layer of such resin. There is nothing in this recitation that implies that other layers of the board contain paper.

Put another way, this recitation of claim 21 only defines the originally claimed “at least one layer of a transparent synthetic resin” by further requiring the resin layer to be paper-free. Applicants submit that the addition of the phrase “paper free” to the originally claimed recitation does not broaden the claim to positively recite, or even imply, other paper-containing layers, as the Examiner appears to contend.

Accordingly, Applicants respectfully request that the objection to the specification be withdrawn.

35 U.S.C. §112 Rejection, First Paragraph

Claims 21 and 22 are rejected under 35 U.S.C. §112, first paragraph. The Examiner maintains the assertion that the recitation “at least one paper free layer of a transparent synthetic resin” is not supported by the written description (i.e., introduces new matter to the claims). Applicants respectfully disagree.

As already discussed above with respect to the objection to the specification, Applicants submit that the original disclosure provides support for this feature of claim 21. Moreover, Applicants note that MPEP §§2163 *et seq.* provides the following guidance regarding the written description requirement of 35 U.S.C. §112, first paragraph:

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc.*

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The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc.*, 935 F.2d at 1563-64, 19 USPQ2d at 1117.

...
If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating “**the description need not be in *ipsis verbis* [i.e., “in the same words”] to be sufficient**”). (emphasis added).

...
The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. (emphasis added).

...
While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.

Applicants respectfully submit that claim 21 has adequate written description because the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, Applicants were in possession of the invention as recited in claim 21. More specifically, the specification begins with a description of the prior art process of printing a decoration onto paper, coating the paper with resin, and then applying the paper/resin layer to a support board. The specification continues with a description of the problems attendant with such paper/resin layers (e.g., paper growth). The specification then describes that, in aspects of the invention, “the decoration is printed directly on the top side of the support board and is covered by at least one layer of transparent synthetic resin” (line 36 of page 2 through line 1 of page 3). The specification subsequently describes that “[b]y virtue of this configuration, the paper layer is eliminated” (page 3, lines 12-13) and “[t]he absence of paper layers prevents the resulting boards from warping” (page 4, lines 7-8). Thus, although the specification does not use the exact phrase

“paper free,” Applicants submit that, when taken as a whole, the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, Applicants were in possession of the invention as now recited in claim 21.

Accordingly, Applicants respectfully request that the §112, first paragraph, rejection of claims 21 and 22 be withdrawn.

35 U.S.C. §102(a or e) Rejection

Claims 1-3 and 19-22 are rejected under 35 U.S.C. §102(a or e) as being anticipated by U.S. Patent No. 6,568,148 issued to Eisermann (“Eisermann”) alone or optionally taken with Vogel or U.S. Patent No. 5,882,569 issued to Maes (“Maes”). This rejection is respectfully traversed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131. Applicants submit that the applied art does not show each and every feature of the claimed invention.

Claims 1-3, 19, and 20

By this amendment, claim 1 is amended to incorporate the subject matter of allowable claim 4. Therefore, claim 1, and claims 2, 3, 19, and 20 that depend from claim 1, should be allowed. As such, the §102 rejection of claims 1-3, 19 and 20 is moot.

Claims 21 and 22

The present invention relates to floor panels. In non-limiting exemplary embodiments of the invention, a support board has a decoration printed onto its top side, thereby avoiding the

problems associated with printing the decoration on paper and then attaching the paper to the support board. More specifically, independent claim 21 recites a decoration is printed directly onto the top side of the support board and is covered by at least one paper free layer of a transparent synthetic resin. Applicants acknowledge that Eisermann discloses that decorative layer 4 may be printed on the top 5a of the support plate 5 (see, e.g., FIG. 7 and lines 38-39 of col, 5). However, Eisermann does not disclose that the decorative layer 4 is covered by at least one paper free layer of resin.

Instead, Eisermann discloses a multi-layered floor covering element that includes at least one paper layer. Each embodiment disclosed by Eisermann comprises a support plate 5, upper face sheet 2, and lower face sheet 6. The lower face sheet 6 includes resin layer 14 and tension layer 13, which Eisermann explicitly discloses is made of paper (col. 4, lines 22-23). Also, the upper face sheet 2 includes resin layer 9 and support layer 7 that consists essentially of cellulose (col. 4, lines 56-57), which the skilled artisan will recognize as a paper layer. Thus, each resin layer (9 or 14) includes a paper layer (7 or 13). As such, Eisermann does not disclose a resin layer that is paper free, and cannot arguably be said to disclose a decoration is printed directly onto the top side of the support board and is covered by at least one paper free layer of a transparent synthetic resin, as recited in claim 21.

Claim 21 also recites that the decoration is printed directly onto the top side of the support board. In the Response to Arguments section of the Office Action, the Examiner asserts that Eisermann discloses this feature at FIG. 1 and claims 6, 8, and 9 (Final Office Action, page 3). Applicant respectfully disagree, and submit that these identified portions of Eisermann do not disclose that the decoration is printed directly onto the top side of the support board. For example, claim 6 recites the decorative layer is applied to one of the bottom surface of the

support layer (7) or the bottom surface of the upper face sheet (2). The support layer 7 and face sheet 2 are not the support board; therefore, claim 6 does not disclose that the decoration is printed directly onto the top side of the support board. Claims 8 and 9 depend from claim 6 and, by definition, contain the same recitation regarding where the decoration is printed (i.e., on either the support layer 7 or the face sheet 2).

Moreover, FIG. 1 shows a prior art board in which the decorative layer 4 is applied to layer 10, which is made of paper (col. 4, lines 11-14). Layer 10 is not the support board; therefore, FIG. 1 does not disclose that the decoration is printed directly onto the top side of the support board.

For all of the above-discussed reasons, Applicants submit that Eisermann does not disclose all of the features of independent claim 21. Therefore, the rejection of claim 21 is improper and should be withdrawn.

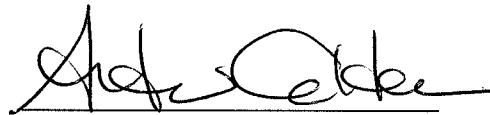
Claim 22 depends from allowable base claim 21, and is distinguishable from the applied art at least for the reasons discussed above with respect to claim 21.

Accordingly, Applicants respectfully request that the §102(a or e) rejection of claims 1-3 and 19-22 be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,
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